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WASHINGTON, DC 20004

EXAMINER
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BORLINGHAUS, JASON M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GLENN MCGARRY and WESLEY FEDORCHAK

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Appeal 2009-011598  
Application 09/764,782  
Technology Center 3600

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Before HUBERT C. LORIN, ANTON W. FETTING, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

The Appellants have filed a request for rehearing under 37 U.S.C. § 41.52 requesting that we reconsider our Decision of March 25, 2010 where we affirmed the rejection of claims 56-58.

## THE INVENTION

The Appellants' claimed invention is directed to a streamlined system for capturing trades that can be operated by the client at its site (Spec. 3:6-10).

## ANALYSIS

The Appellants argue that in the Decision on Appeal dated March 25, 2010 misapprehended or overlooked some points in reference to claims 56-58 (Request 2). The Appellants first argue that standard for inherency has not been met (Request 2). The Appellants argue second that the claimed features are not taught or suggested in the prior art and that obviousness has not been established (Request 3-4).

Claim 56, which is representative, requires that the "deal management computer" is:

*"[in communication with a plurality of internal systems, each of the internal systems being associated with one or more product types, and the captured information being routed to at least one of the plurality of internal systems"]*.

The Decision on Appeal of March 25, 2010 in regards to claims 56-58 stated that "[i]f not inherent in the Sandhu system, the use of a separate internal system being associated with each product type would be an obvious

expedient to permit processing if one system failed” (Decision on Appeal, 9).

The Appellants have first argued that the limitations of claim 56 are not inherent. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). Here, Sandhu actually does show the claimed features of claim 56 in Fig. 1. Sandhu’s Fig. 1 shows the CFOWebSystem and Back-End System (*deal management computers*) connected to several provider systems such as pricing 40, payments 50, trading 60, confirmation 70, and settlement 80 systems (*with 40, 50, 60, 70, and 80 serving as internal systems*) and associated with *one* or more *product types* thus meeting the limitations of claims 56-58. Note that the claims 56-58 only require “*one* or more product types” and that only *one* product type would meet the cited claim limitation.

In regards to the Appellants second argument, even if Fig. 1 were to not show the claimed features of claims 56-58 in some manner, such a modification would have been obvious to permit processing if one system failed or if systems were required at separate locations. “Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR*

*Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The Court in KSR also stated that in a Section 103 analysis that “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id* at 418. Here one of ordinary skill in the art would have seen the advantage of using separate internal systems if desired for each product type to permit use of those systems if one system failed or if systems were required at separate locations. Such a modification would have been obvious and well within the skill level of one of ordinary skill in the art and readily inferred at the time the invention was made.

In light of the above, the Appellants Request does not persuade us that we erred in affirming the rejections of claims 56-58 35 under U.S.C. § 103(a) as unpatentable over Sandhu and McErlean.

#### DECISION

Accordingly, the Appellants request for rehearing is denied.

#### DENIED

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